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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Enrique David Sancho

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

07/24/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/688,734	Applicant(s) SANCHO, ENRIQUE DAVID	
	Examiner JOHN M. WINTER	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-36 and 40-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-36 and 40-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/4/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The Applicants' amendment filed on January 22, 2009 is hereby acknowledged, 34-36, 40 and 43-44 remain pending. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 34-36, 40 and 43-44 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
4. Claims 34-36 are rejected based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88

(1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

5. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 34 fails prong (1) because the “tie” (e.g. receiving at a mini-server) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

6. Claims 40 and 43-44 are “software per se” the claimed “structure” of the invention is composed entirely of software (e.g. module, interface) and as such is non-statutory.
7. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760

(claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. (MPEP 2106.01 --FUNCTIONAL DESCRIPTIVE MATERIAL: "DATA STRUCTURES ")

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 40 and 43-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claim 40 recites "message containing information indicating that a user was verified" however there is no corresponding structure in either the first or second input unit that implements any verification process, and is therefore indefinite.
10. Claim 40 is indefinite because it is a hybrid claim. In particular, the claim appears to be directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention. Evidence to support an interpretation that claim 17 is a *product* is (1) the preamble which states "a vendor computer " and (2) the body of the claim which recites "a first input unit" Alternatively, evidence that indicates the claim is directed to a *process* or method is the body of the claim which recites "to communicate with a second server to receive a second server message containing information indicating that a user was verified,the

verification being based on a first identification for the user, generated using the first computer fingerprint file. . . ." Because of this conflicting evidence, it is unclear if claim 17 is a product or process claim. See the 35 U.S.C. §101 rejection above. See MPEP §2173.05(p) II or Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990). For prior art purposes, the Examiner interprets the claim as being drawn to a product claim.

11. Claims 43-44 are dependant upon the above rejected claims and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-36, 40 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare Jr. et al. (US Patent 6,269,348) in view of Glass et al. (US Patent 6,332,193).

12. As per claims 34 and 40,

Pare Jr. et al ('348) discloses a method for verifying a user and a user computer comprising:

receiving at a first mini-server at least one first mini-server message from the user computer, the at least one first mini-server message including a first computer fingerprint

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file: the first computer fingerprint file identifying the user computer; (Column 11, lines 39-42)

13. comparing the first computer fingerprint file against a second computer fingerprint file to verify the user computer, the second computer fingerprint file accessible by the first mini-server; (Column 11, lines 39-45)

14. Pare Jr. et al ('348) does not specifically disclose a "receiving at a second mini-server at least one second mini-server message from the user computer, the at least one second mini-server message including the first identification for the first identification being based on the first computer fingerprint file identifying the user computer; and comparing the first identification for the user against a second identification for the user to verify the user, the second identification for the user accessible by the second mini-server; and after the comparing of the first identification for the user against the second identification for the user to verify the user, generating a third mini-server message at the second mini-server based upon the results of the comparison.

"; Glass et al ('193)discloses a ""receiving at a second mini-server at least one second mini-server message from the user computer, the at least one second mini-server message including the first identification for the first identification being based on the first computer fingerprint file identifying the user computer; and comparing the first identification for the user against a second identification for the user to verify the user, the second identification for the user accessible by the second mini-server; (Column 10, lines 30-35) and after the comparing of the first identification for the user against the second identification for the user to verify the user, generating a third mini-server

message at the second mini-server based upon the results of the comparison. (Column 10, lines 30-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Pare Jr. et al ('348) reference in view of Glass et al ('193) in order to restrict prosecution of a transaction to a specific user/machine pair.

15. Claims 40 and 43-44 are in parallel with claim 34 and are rejected for at least the same reasons.

16. As per claim 35,

Pare Jr. et al ('348) discloses a method for verifying a user and a user computer comprising:

- a. sending the first mini-server message to a vendor computer; and sending the second mini-server message to the vendor computer.(Column 11, lines 45-48)

17. As per claim 36,

Pare Jr. et al ('348) discloses a method according to claim 35 further comprising:

authorizing an action by the vendor computer only if both the first mini-server message

contains information indicating the user computer was verified and the second mini-server message contains information indicating the user was verified.(Column 11, lines 39-42; Figure 6)

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685